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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kuk Ho Bae

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34610

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08/23/2004

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EXAMINER

BROCKETTI, JULIE K

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,574

Applicant(s)

BAE ET AL.

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "the user" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto, U.S. Patent No. 5,489,103. Okamoto discloses a game service receiving method comprising extracting a game list comprising game-related information from a transport stream that includes image and audio information, a listing of game programs and the game-related information (See Okamoto Figs 1 & 5; col. 6 lines 23-31). A game program desired by a user can be downloaded according to the game-related information. The game program is stored in a game memory portion of the receiving device. The game is also executed when desired by a user (See Okamoto col. 7 lines 63-66; col. 6 lines 32-43) [claim 16].

Claims 2-4 and 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Reed et al., U.S. Patent No. 5,944,608. Reed discloses a game service transmitting device, system and method that comprises a multiplexer configured to convert image and audio information, a game program and game-related information into a transport stream (See Reed Fig. 12; col. 2 lines 4-14; col. 16 lines 57-67; col. 17 lines 1-18). A transmitting unit encodes, i.e. channel-codes, the transport stream (See Reed abstract). Furthermore, the transport stream is modulated, amplified and transmitted over a certain channel to a receiving unit when requested by a user (See Reed Fig. 12; col. 16 lines 28-30, 63-67; col. 17 lines 4-5) [claims 2, 14]. The system comprises a game server configured to provide game programs and game-related information [claim 3]. The server is configured to receive a game-

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ordering signal indicating a game desired by a user and to provide the selected game program and game-related information (See Reed Figs. 12-14; col. 4 lines 17-23; abstract) [claim 4].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al., U.S. Patent No. 5,944,608. Reed discloses all of the limitations mentioned above and also teaches of updating the CATV transmitter and installing new games and options (See col. 2 lines 4-14; col. 13 lines 62-67) [claim 15]. Consequently, it is clear that the operator of the CATV transmission can add a new game program desired by a user and game-related information to a previously established game list. The new game program and game-related information would be converted into a transport stream. Reed lacks in specifically disclosing that newly installed games are desired by a user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to install new games desired by a user. By installing new games desired by a user, the system is giving its customers the games in which

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they want to play. Therefore, if the games the customers want are implemented into the system, these individuals will remain customers. Furthermore, the level of excitement in the games and system remains high, which increases the number of customers.

Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto, U.S. Patent No. 5,489,103. Okamoto discloses all of the limitations mentioned above. An extracted game list is displayed to a user on a screen (See Okamoto Fig. 5). The user requests a game program from a transmitting party (See Okamoto Fig. 6). It is clear that the user may request a game program from the transmitting party when the game program selected is not included in the displayed game list. In the system of Okamoto, a user enters the number of the game they wish to play, it is clear that a player may enter an invalid number [claims 17 & 19]. For example, if there are only games 1-5, the player can still enter the number 9 and an error may be generated or no game is provided. Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users to select games that are not included on a displayed list. This is similar to a user selecting a television channel on their TV set that they do not get image information. Nothing stops a user from attempting to get a game that is not available. It is a matter of curiosity to select game or channels that are not available and see whether or not they are truly not available.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto in view of Hawkins et al., U.S. Patent No. 6,005,561.

Okamoto lacks in disclosing using packet identifiers. Hawkins et al. teaches of an interactive information delivery system in which game-related information comprises a packet identifier (PID) configured to identify a packet of a game program ordered by a user and a game list (See Hawkins et al. col. 13 lines 42-55; Fig. 8) [claim 18]. It would have been obvious at the time the invention was made to include packet identifiers. By using packet identifiers, one can determine the location within the broadcast stream of the game requested by a user. Consequently, locating and retrieving the game program is easier and faster.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzuri, "EE 4984 Telecommunication Networks Project 1, Sega Channel" in view of Hawkins. "Sega Channel" is a broadcast and game-receiving device. A downloader is configured to receive a broadcast signal and to download a game program ordered by a user. A game memory is configured to store the downloaded game program for access by a user when desired. A CPU, i.e. the video game machine, is configured to execute the stored game program in response to a user request (See "Sega Channel"; See Hawkins col. 3 lines 25-47) [claim 20]. Sega Channel lacks in stating that the game-related information is encoded in the broadcast signal. Hawkins teaches of an interactive information delivery system. Game-related information is encoded

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in a broadcast signal for users to receive (See Hawkins col. 6 lines 38-42) [claim 20]. It would have been obvious at the time the invention was made to encode the data in Sega Channel. Encoded signals provide greater security in transmission and are less likely to be tampered with.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al., U.S. Patent No. 5,944,608 in view of Okamoto, U.S.

Patent No. 5,489,103 in view of Okano et al., U.S. Patent No. 6,320,868

B1. Reed discloses a game service transmitting device and method that uses a multiplexer for converting image and audio information, a game program and game-related information into a transport stream (See Reed Fig. 12; col. 2 lines 4-14; col. 16 lines 57-67; col. 17 lines 1-18) [claim 1]. A transmitting unit encodes, i.e. channel-codes, the transport stream (See Reed abstract) [claim 1]. Furthermore, the transport stream is modulated, amplified and transmitted over a certain channel (See Reed Fig.12; col. 16 lines 63-67) [claim 1]. Reed lacks in specifically disclosing a tuning unit. Okamoto discloses a game services receiving device. The device comprises a tuning unit configured to receive image and audio information, a game program ordered by a user and game-related information. The tuning unit is configured to select either image and audio information corresponding to a channel desired by a user or a game program ordered by the user (See Okamoto Fig. 1; col. 4 lines 39-54; 64-67) [claim 1]. A common game interface module is configured to demodulate and process a selected game program and game-related information (See Okamoto

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Fig. 1) [claim 1]. The game program can also be downloaded and stored in a game memory portion of the common game interface unit for access by a user when desired (See Okano col. 7 lines 62-66) [claim 1]. Okamoto lacks in disclosing error correction. Okano et al. teaches of a transmission/reception system and receiver in which error correction occurs on the transmitted signal (See Okano Fig. 3; col. 14 lines 6-20) [claim 1]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to error correct the transmitted signal. During transmission, errors may occur in the signal. Error correction is done to allow for reconstruction of the data after some of the data may have been the subject of error in the transmission. By error correcting the signal, one receives a complete and usable signal. Consequently, it is obvious to error correct any transmitted signal so that what is received is capable of being used.

Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto in view of Okano et al. Okamoto discloses a game services receiving device. The device comprises a tuning unit configured to receive image and audio information, a game program ordered by a user and game-related information. The tuning unit is configured to select either image and audio information corresponding to a channel desired by a user or a game program ordered by the user (See Okamoto Fig. 1; col. 4 lines 39-54; 64-67). A common game interface module is configured to demodulate and process a selected game program and game-related information and to store the game

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program for access by a user when desired (See Okamoto Fig. 1) [claim 5]. The game program can also be downloaded (See Okano col. 7 lines 62-66).

Okamoto lacks in disclosing error correction. Okano et al. teaches of a transmission/reception system and receiver in which error correction occurs on the transmitted signal (See Okano Fig. 3; col. 14 lines 6-20) [claim 5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to error correct the transmitted signal. During transmission, errors may occur in the signal. Error correction is done to allow for reconstruction of the data after some of the data may have been the subject of error in the transmission. By error correcting the signal, one receives a complete and usable signal. Consequently, it is obvious to error correct any transmitted signal so that what is received is capable of being used.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto in view of Okano et al., in further view of Lazzuri, "EE 4984 Telecommunication Networks Project 1, Sega Channel". Okamoto and Okano lack in disclosing a downloader. "Sega Channel" teaches of a common game interface module, which includes a downloader for downloading a game program ordered by a user using the game-related information. The interface module further comprises a game memory for storing a downloaded game program and a CPU, i.e. the game machine, for executing the stored game program. The CPU executes the game program upon receipt of a controlling command input through a user interface (See "Sega Channel") [claims 6-8]. It

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would have been obvious to one of ordinary skill in the art at the time the invention was made to include a downloader in the invention of Okamoto so that the games are capable of being downloaded and stored thereby being capable of being executed directly from the game interface without having to link to the broadcast signal every time a user wishes to play the game. By downloading the games into memory they are capable of being played while not being connected to the broadcast signal, which gives flexibility to the gaming interface.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dureau, U.S. Patent No. 6,513,160 B2 in view of Okano et al., in further view of Lazzuri, "EE 4984 Telecommunication Networks Project 1, Sega Channel". Dureau discloses a game service-receiving device. A processor is configured to receive an input from a user interface (See Dureau Figs. 1 & 5; col. 7 lines 26-34). The processor is configured to output either a first control signal to select a broadcast signal of a channel desired by a user or a second control signal to order a game desired by the user (See Dureau Figs. 1 & 5; col. 3 lines 65-67; col. 4 lines 1-56). A modem is configured to receive the second control signal and to output a corresponding game ordering signal (See Dureau Fig. 3). A common game interface module is configured to receive the first control signal and to demodulate the broadcast signal of a channel selected by the user and a game program and came program information. The common game interface processes demodulated game-related information (See

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Dureau Fig. 1; col. 4 lines 18-43) [claim 9]. The game is stored in memory so as to allow a user to view the selected channel or execute the selected game (See Dureau col. 5 lines 29-44) [claim 9]. The common interface host provides a resource for processing the game program and game-related information (See Dureau col. 4 lines 44-56; col. 7 lines 6-24) [claim 10]. Dureau lacks in disclosing error correcting and downloading. Okano et al. teaches of a transmission/reception system and receiver in which error correction occurs on the transmitted signal (See Okano Fig. 3; col. 14 lines 6-20) [claim 9]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to error correct the transmitted signal. During transmission, errors may occur in the signal. Error correction is done to allow for reconstruction of the data after some of the data may have been the subject of error in the transmission. By error correcting the signal, one receives a complete and usable signal. Consequently, it is obvious to error correct any transmitted signal so that what is received is capable of being used. "Sega Channel" teaches of a common game interface module, which includes a downloader for downloading a game program ordered by a user using the game-related information. The interface module further comprises a game memory for storing a downloaded game program and a CPU, i.e. the game machine, for executing the stored game program. The CPU executes the game program upon receipt of a controlling command input, i.e. signal, through a user interface (See "Sega Channel") [claims 9, 11, 12, 13]. It would have been

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obvious to one of ordinary skill in the art at the time the invention was made to include a downloader in the invention of Dureau so that the games are capable of being downloaded and stored thereby being capable of being executed directly from the game interface without having to link to the broadcast signal every time a user wishes to play the game. By downloading the games into memory they are capable of being played while not being connected to the broadcast signal, which gives flexibility to the gaming interface.

Response to Amendment

It has been noted that claims 1-20 have been amended.

Response to Arguments

Applicant's arguments filed June 10, 2004 have been fully considered but they are not persuasive.

Applicant argues that Okamoto teaches requesting and transmitting game data from a game database rather than extracting a game list and game related information from a transport stream. The Examiner disagrees and notes that the data is transmitted from the database to a transport stream (See Okamoto Fig. 2 item 200; col. 6 lines 27-29). It is from this transport stream that the data is extracted. Applicant further argues that Okamoto teaches that the game data is automatically deleted after a predetermined amount of elapsed time while the claimed invention stores game data in a memory portion

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of the receiving device for execution by a user at a later time, if desired. While the Examiner agrees with Applicant that Okamoto teaches that the game data is automatically deleted after a predetermined amount of time, the Examiner does not believe that this is contrary to the claim language of claim 16.

Okamoto clearly discloses downloading a game program and storing the game program in a game memory portion of a receiving device (See Okamoto col. 6 lines 32-42). The fact that the program is stored only for a predetermined period of time does not matter, as Applicant's claim language does not state that the program is permanently stored in the memory. Furthermore, Applicant's claim language states: "executing the game when desired by a user". In Okamoto the player may execute the game until it is deleted from the memory. This can be at any time desired by the user. Therefore even though the game program will eventually be deleted in Okamoto, the reference still anticipates Applicant's claim language in that in Okamoto the game program is stored in memory and is capable of being executed when desired by a user.

Applicant argues that Reed's transmitter apparatus simply codes and transmits game data across a cable line and does not disclose or suggest that the transport stream is also amplified and modulated on the transmitting end. The Examiner disagrees and references Figure 12 in Reed. The transport stream is clearly modulated (See Reed Fig. 12, item 306) and amplified (See Reed Fig. 12, item 308) before it is transmitted.

The Applicant argues that claim 15 is allowable over read for reasons discussed above with respect to claim 14. The Examiner disagrees and notes the reasons why Reed does anticipate claim 14 are mentioned above.

Applicant argues that claims 17 & 19 are allowable over Okamoto for the reasons discussed above with respect to claim 16. The Examiner disagrees and notes the reasons why Okamoto does anticipate claim 16 are mentioned above.

Applicant argues that claim 18 is allowable over Okamoto in view of Hawkins for the reasons discussed above with respect to claim 16. The Examiner disagrees and notes the reasons why claim 16 is anticipated by Okamoto are mentioned above.

Applicant argues that Lazzuri does not disclose or suggest a game memory configured to store the downloaded game program for access by a user when desired and a CPU configured to execute the stored game program in response to a user request. The Examiner disagrees and notes that while Applicant may be correct in stating that the downloaded game only remains available as long as the Sega Genesis machine is turned on, this fact does not make Lazzuri not read on Applicant's claim language since the game is still downloaded to a game memory for access by a user when desired, i.e. when the game machine is turned on and the player is ready to play the game. Nowhere in Applicant's claim does it state that the game program is downloaded and stored in the game memory permanently. Therefore, the combination of Lazzuri and Hawking meet the claim limitations.

In regards to claim 1, Applicant argues once again that Okamoto fails to teach of “downloading the game program and storing it in a game memory portion of the common game interface unit for access by a user when desired and to process the game-related information” due to the fact that Okamoto deletes the game data after a predetermined amount of elapsed time and thus would not be stored in game memory for access by a user when desired. The Examiner disagrees and references Applicant to the Examiner’s response to this argument above.

Applicant argues that claim 5 is allowable based on the fact that Okamoto does not disclose or suggest “a common game interface module configured to demodulate a selected game program and game-related information, to error correct, download, and process the demodulated game program and game related information, and to store the game program for access by a user when desired.” The Examiner disagrees and notes that Okamoto discloses all limitations except for error correction in which the Okano reference is used to teach this limitation. Please refer to the aforementioned arguments in regard to storing the game program.

Applicant argues in regards to claims 6-8 that Lazzuri merely discloses a means by which games are downloaded and stored and that the storage is temporary, and that a user’s access to the game is only active while the Sega Genesis machine is on. The Examiner agrees with Applicant’s analysis of Lazzuri. However, it still reads on the claim language. As stated previously the

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fact that in both Okamoto and Lazzuri the game storage is temporary does not mean that a player cannot access the game program "when desired". A player's desire for the game program can occur when the game machine is turned on and the game program is still in memory. The claim language does not state that the game program is permanently stored in the memory. Consequently, the combination of Lazzuri and Okamoto read on the claim language.

Applicant argues that Dureau lacks in disclosing the limitations of claim 9; specifically that Dureau does not download, store and execute a game, which is independent of the television game program. The Examiner disagrees. Dureau clearly stores the game, i.e. the genie game which is independent of the television program, in ROM in the set-top box. The program can be executed (See Dureau col. 5 lines 29-44). Therefore Dureau clearly discloses storing and executing a game. While Dureau does not specifically state that the game is downloaded, the reference Lazzuri teaches this limitation. Therefore, the combination of Dureau, Lazzuri and Okano teach all limitations of claims 9-13.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

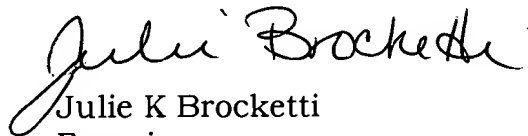
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shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Julie K Brockett
Examiner
Art Unit 3713